



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,702	11/09/2001	Keith W. Diveley	020375-004010US	4413

20350 7590 07/28/2004

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

REAGAN, JAMES A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,702

Applicant(s)DIVELEY, KEITH W. **Examiner**

James A. Reagan

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This action is in response to the application filed on 09 November 2001.
2. Claims 1-37 have been examined.

Information Disclosure Statement

3. The Information Disclosure Statements filed on 18 April 2003, and 09 September 2003, have been considered. Initialed copies of the Form 1449 are enclosed herewith.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 8-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lorsch (US 5,903,633 A).

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as

potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim 1:

Lorsch, as shown, discloses the following limitations:

- *receiving a set of identifiers from a consumer provider that are associated with a good or a service of the consumer provider (see at least column 1, lines 29-31);*
- *receiving a request to pay for the good or service, wherein the request includes one of the identifiers and a payment (see at least column 8, lines 34-39);*

Lorsch does not specifically disclose:

- *creating an electronic record of the payment; and*
- *electronically sending the payment record to the consumer provider.*

However, Lorsch, in at least column 8, lines 40-62 discloses adding minutes to the phone card using a POS device, paying for the minutes, debiting the clients checking account, and recording the transaction on a database, essentially disclosing the limitations aforementioned. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the prepaid phone card activations and billing method of Lorsch because it provides an efficient and secure method of offering a simple communication system to a consumer.

Claim 2:

Lorsch does not specifically disclose *electronically transferring the payment to a bank account of the consumer provider*. However, Lorsch does disclose debiting the clients checking account. Naturally, the amount debited would be credited to the providers account.

Claims 3, 8, 9, 14, 23, and 30:

With regard to the limitations of:

- *sending information from the payment record to a switch that is configured to add minutes to a cell phone based on the information;*
- *the identifiers are associated with stored value cards, wherein the request to pay for the service comprises a request to pay for one of the cards, and wherein receipt of the electronic payment record is used to activate the stored value card;*
- *the stored value card includes phone time;*
- *a switch in communication with the host computer, wherein the switch is configured to add phone time to a phone upon receipt of the payment information from the host computer;*
- *the service comprises phone service, and further comprising adding time to the phone upon presentment of the identifier to the consumer service provider; and*
- *the service comprises phone service, and further comprising activating a phone upon presentment of the identifier to the consumer service provider.*

See Lorsch, in at least column 8, lines 40-62, and the rejection of claim 1 above.

Claim 4:

With regard to the limitation of *the request is entered into a terminal having a processor, and wherein the payment record is transferred electronically from the terminal to a host computer*, see Lorsch, in at least column 8, lines 40-62, and the rejection of claim 1 above.

Claim 5:

With regard to the limitation of *the payment record is further transmitted from the host computer to the consumer provider*, Lorsch effectively discloses payment records and receipts being processed, sent, and stored on the centralized computer, invoice computer, and central database in at least Figure 1 and associated text.

Claim 6:

With regard to the limitation of *the set of identifiers are associated with enrollment information obtained from consumers enrolling with the consumer provider, and further comprising electronically sending enrollment information from the consumer provider to the host computer*, Lorsch discloses activation of the card in at least column 1, lines 8-12, essentially disclosing enrolling the card and card user based upon the account and PIN of the phone card.

Claim 10:

With regard to the limitation of *at least some of the identifiers are associated with a payment amount as determined by the consumer provider*, Lorsch, in at least column 1, lines 41-48, discloses an account number associated with a predetermined talk time.

Claim 11:

With regard to the limitation of *the payment amount is for a good offered by a consumer provider over the television*, the Examiner takes **Official Notice** that it is old and well known in the arts to advertise on television, because it reaches many consumers.

Claim 12:

With regard to the limitations of:

- *a host computer; and*
- *a database associated with the host computer,*
- *the database having a record of a set of identifiers that are associated with a consumer provider;*

- *wherein the host computer is configured to receive a record containing one of the identifiers along with information on a payment,*
- *to send information from the record to the consumer provider, and*
- *to electronically facilitate the sending of the payment to a bank of the consumer provider;*

See the rejections of claims 1 and 2 above.

Claim 13:

With regard to the limitations of *at least one terminal having a processor that is capable of communicating with the host computer, and wherein the terminal is configured to receive the identifier and payment information and to transmit the payment information to the host computer*, see the rejections of claims 4 and 5 above.

Claims 15, 21, 28, and 36:

With regard to the limitations of:

- *a printer coupled to the terminal to print a receipt showing the payment;*
- *the receipt comprises a sheet of paper having the identifier printed thereon;*
- *the identifier is issued on a receipt comprising a sheet of paper having the identifier printed thereon; and*
- *producing a receipt having an identifier that indicates payment has been made;*

Lorsch discloses a POS terminal in at least Figure 1, plainly disclosing a printing device that prints the transaction and relevant transaction data such as account numbers and payment amounts.

Claim 16:

With regard to the limitations of:

- *receiving a set of identifiers from a consumer service provider that are presentable to the consumer service provider to receive a service from the consumer service provider;*
- *receiving a request to pay for the service along with a payment;*
- *associating the payment with one of the identifiers;*
- *creating an electronic record of the payment along with the associated identifier; and*
- *issuing a receipt that includes the identifier, wherein the identifier is presentable to the consumer service provider to receive the service;*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 28, and 36 above.

Claim 17:

With regard to the limitation of entering information on the payment into a terminal having a processor and that contains a record of the associated identifier, see the rejection of claim 1 above.

Claim 18:

With regard to the limitation of *sending the payment information and the associated identifier from the terminal to a host computer*, see the rejection of claim 1 above.

Claim 19:

With regard to the limitation of *sending the payment information and the associated identifier from the host computer to the consumer service provider*, see the rejection of claim 2 above.

Claim 20:

With regard to the limitation of *each identifier is associated with a fixed payment amount*, the Examiner takes **Official Notice** that it is old and well known in the credit card arts to require a minimum monthly payment.

Claim 22:

With regard to the limitation of *sending the payment to a bank account of the consumer service provider, and sending payment information along with the associated identifier to the consumer service provider*, see the rejection of claim 2 above.

Claim 24:

With regard to the limitations of:

- *a terminal having an input device and a printer;*
- *a host computer having a record of identifiers that are associated with a service;*
- *wherein the terminal is capable of communicating with the host computer to receive the identifiers, of receiving payment information using the input device, of associating one of the identifiers with the payment information, and to send payment information and the associated identifier back to the host computer, and*
- *wherein the terminal is configured to print a receipt with the identifier.*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 28, and 36 above.

Claim 25:

With regard to the limitations of:

- *electronically receiving account information from a consumer service provider, the account information including a required payment for service activation;*

- *entering payment information into a terminal and creating an electronic record of the payment; and*
- *issuing an identifier that is presentable to the consumer service provider to activate the service;*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 28, and 36 above.

With regard to the limitation of *the account information including a required payment for service activation, and receiving a request to make the required payment along with the payment*, the Examiner takes **Official Notice** that it is old and well known in the credit card arts to pay a nominal up front administrative, processing, or activation fee.

Claim 26:

With regard to the limitation of *sending the payment information and the associated identifier to a host computer*, see the rejections of claims 1 and 2 above.

Claim 27:

With regard to the limitation of *sending the payment information and the associated identifier from the host computer to the consumer service provider*, see the rejections of claims 1 and 2 above.

Claim 29:

With regard to the limitation of *sending the payment to a bank account of the consumer service provider, and sending payment information along with the associated identifier to the consumer service provider*, see the rejections of claims 1 and 2 above.

Claim 31:

With regard to the limitations of:

- *a terminal having an input device and a printer;*
- *a host computer having a service activation account information and an associated identifier; wherein the terminal is capable of communicating*

with the host computer to receive the service account information and the associated identifier, of receiving payment information using the input device, of associating the identifier with the payment information, and to send payment information and the associated identifier back to the host computer, and wherein the terminal is configured to print a receipt with the identifier; and

- *wherein the identifier is presentable to the consumer service provider to activate the service.*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 25, 28, and 36 above.

Claims 32-35:

With regard to the limitations of:

- *receiving a request from a payor to pay a payee a payment, wherein the request includes the location of the payee;*
- *entering the request into a terminal;*
- *calculating a tax that is associated with the payment;*
- *receiving the payment and the associated tax from the payor and entering payment information into the terminal;*
- *electronically sending the payment and the tax to a bank account of the payee from the terminal.*
- *sending an electronic report to the payor showing the amount of payment and the tax;*
- *establishing a communication link between the terminal and a host computer, and wherein the host computer is configured to calculate the tax based on the location of the payee; and*
- *displaying the amount of the tax at the terminal.*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 25, 28, and 36 above.

With regard to the limitations regarding the displaying and collecting of taxes and taxes based on location the Examiner takes **Official Notice** that it is old and well known in the taxation arts to assess a tax surcharge to any transaction based upon the location of the transaction, such as the consumer's state of residence.

Claim 37:

With regard to the limitations of:

- *a terminal having an input device and a printer;*
- *a host computer that is configured to communicate with the terminal; and*
- *a database associated with the host computer;*
- *wherein the terminal is configured to receive payment information along with a location of a payor, wherein the host computer is configured to obtain tax information from the database based on the location of the payor and to transmit the tax information to the terminal,*
- *wherein the terminal is configured to display the tax information and to transmit payment information to the host, and*
- *wherein the host computer is configured to transmit the payment information to a payee and to facilitate an electronic transfer of the payment and the tax to a bank account of the payee.*

See the rejections of claims 1 and 2 above, as well as the rejections of claims 15, 21, 25, 28, 32-35, and 36 above.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lorsch in view of Vulcan et al. (US 5,799,072 A).

Claim 7:

Lorsch discloses the prepaid phone card activations and billing method as shown above in the rejection of claim 1. Lorsch does not specifically disclose *periodically receiving updated enrollment information at the host computer*. Vulcan, however, in at least the abstract and other associated text discloses updating a client database on a regular basis, essentially disclosing that personal and account information regarding prepaid phone cards and their users is also easily updated. It would have been obvious to one of ordinary skill in the art at the time of the invention to regularly update their client database because this maintains current contact and billing formation.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including

After Final communications labeled "Box AF"]

(703) 308-1396 [Informal/Draft communications, labeled "PROPOSED"
or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JAR
26 July 2004

